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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09 779,116	02 08 2001	Michael J. Broadhurst	20611	7682

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HOFFMANN-LA ROCHE INC.
PATENT LAW DEPARTMENT
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EXAMINER

WRIGHT, SONYA N

ART UNIT PAPER NUMBER

1626

DATE MAILED: 01 29 2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/779,116

Applicant(s)

BROADHURST ET AL.

Examiner

Sonya Wright

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-73 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) ⁶⁵68 and 73 is/are rejected.
- 7) ☒ Claim(s) 1-67 and 69-72 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claims 1-73 are pending in this application.

Election/Restrictions

Claims 1-73 are generic to a plurality of disclosed patentably distinct species. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

Should Applicant traverse on the ground that the species are not patentably distinct, Applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Upon the election of a single disclosed species, a generic concept inclusive of the elected species will be identified by the examiner for examination along with the elected species.

In a telephone conversation on January 10, 2001, Mr. Dennis Tramaloni elected the first species of claim 23 with traverse. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim

remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

The following generic concept as depicted in claim 1 is identified for examination, inclusive of the elected embodiment: R¹ is oxazolyl and R²-R⁸ are as defined except that R⁴ and R⁸ do not join together with the nitrogen atom to which they are attached to form a heterocycle. The remaining subject matter of claims 1-73 stands withdrawn from further consideration under 37 CFR 1.142(b) as constituting other patentably distinct inventions.

The withdrawn subject matter of claims 1-73 is properly restricted as said subject matter differs in structure and element from the elected subject matter so as to be patentably distinct therefrom, i.e. a reference which anticipated the elected subject matter would not even render obvious the withdrawn subject matter and fields of search are not co-extensive.

Claims 1-73 are objected to as containing non-elected subject matter. This objection may be overcome by limiting the claims to the elected subject matter identified *supra*.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 68 and 73 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as

to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. For rejections under 35 U.S.C. 112, first paragraph, the following factors must be considered (In re Wands, 8 USPQ2d 1400, 1404 (CAFC, 1988)):

- 1) Nature of invention.
- 2) State of prior art.
- 3) Level of ordinary skill in the art.
- 4) Level of predictability in the art
- 5) Amount of direction and guidance provided by the inventor.
- 6) Existence of working examples.
- 7) Breadth of claims.
- 8) Quantity of experimentation needed to make or use the invention based on the content of the disclosure.

Claims 68 and 73 are directed to "interferon or a derivative thereof". The specification does not reasonably provide enablement for the instantly claimed compounds.

The specification does not enable any person skilled in the art to which it pertains to make or use the invention commensurate in scope with this claim. In particular, the specification fails to enable the skilled artisan to practice the invention without undue experimentation. The prior art does not indicate which "interferon compounds or derivative" may be useful in the claimed invention. There is little predictability in the art of which modifications may be made to compositions containing the claimed compound that would retain the composition's ability to be useful as a pharmaceutical. The terms "interferon" and "derivative" may encompass a great number of compounds however, without some guidance as to what changes may be made to compositions of the instant

compounds, there would be little predictability in using such "interferon compounds" or "derivative(s)". The level of ordinary skill in the art is high. The skilled artisan would have a numerous amount of modifications to perform in order to obtain a composition containing "interferon or a derivative thereof" as claimed. Therefore undue experimentation would be required to prepare a composition containing "interferon or a derivative" which has pharmaceutical use as an inhibitor of IMPDH. This rejection can be overcome by Applicant indicating which interferon compounds are useful and by deleting the term "derivative".

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 65 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In compound (VIII), it appears that R^1 should be R^{10} . Also, it appears that claim 65 should be dependent on claim 14, not claim 4, because claim 4 does not define substituents R^9 and R^{10} . Appropriate correction is suggested.

Claim Objections

Claim 31 is objected to because of the following informalities: Two claims are numbered as claim "31". The claims following the first claim 31 need to be renumbered. Appropriate correction is required.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sonya Wright, whose telephone number is (703) 308-

4539. The examiner can normally be reached on Monday-Friday from 8:00 AM - 5:30 PM.

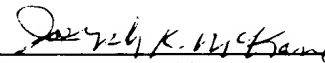
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Joseph K. McKane, can be reached at (703) 308-4537. The Unofficial fax phone number for this Group is (703) 308-7922. The Official fax phone numbers for this Group are (703) 308-4556 or 305-3592.

When filing a FAX in Technology Center 1600, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communications with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [joseph.mckane@uspto.gov]. All Internet e-mail communications will be made of record in the application file. PTO employees will not communicate with applicant via Internet e-mail where sensitive data will be exchanged or where there exists a possibility that sensitive data could be identified unless there is of record an express waiver of the confidentiality requirements under 35 U.S.C. 122 by the applicant. See the Interim Internet Usage Policy published by the Patent and Trademark Office Official Gazette on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, whose telephone number is (703) 308-1235.

Art Unit: 1626



Joseph K. McKane

Supervisory Patent Examiner

Group 1600

Sonya Wright

January 24, 2002